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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,270	01/16/2001	Jerry Ok	S125-USA	5828

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SECOND SIGHT, LLC
P.O. BOX 905
SANTA CLARA, CA 91380

EXAMINER

DAHBOUR, FADI H

ART UNIT PAPER NUMBER

3742

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,270

Applicant(s)

OK ET AL.

Examiner

Fadi H. Dahbour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-19 is/are allowed.
- 6) ☒ Claim(s) 1,2,6-8,20 and 21 is/are rejected.
- 7) ☒ Claim(s) 3-5,9 and 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. Figures 1, 2 & 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 6-8, 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Michelson.

Regarding claims 1-2, Michelson discloses a prosthesis for at least partially restoring vision to a user suffering from a photoreceptor degenerative condition (Figs.1-6), including a secondary coil (37 of Figs.2-3, also see "coil" in line 8 of col.5) for mounting in the vitreous body of a user's eye (Fig.1B) for responding to a coupled input signal to produce an output signal (Fig.6), an electrode array configured for implantation in the user's eye (Figs.4-5, also see "electrode array" in lines 46 & 49 of col.2), signal processing circuitry responsive to the output signal for applying an image signal to the electrode array for stimulating retina cells in the user's eye (Fig.6), wherein the signal

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processing circuitry is contained in a hermetically sealed housing (see "encased in a biologically inert housing" in lines 15-16 of abstract) configured for mounting in the vitreous body (Fig.1B).

Regarding claims 6-8, Michelson discloses in combination with a user's eye characterized by a lens and a sclera wall enclosing a vitreous chamber containing a vitreous body, and including a retina supported adjacent to the vitreous body proximate to the intraocular side of the sclera wall (Fig.1B), a visual prosthesis comprising a secondary coil for responding to input signal energy to produce an output signal (37 of Figs.2-3, also see "coil" in line 8 of col.5), the coil being mounted in the vitreous chamber in thermal contact with the vitreous body (Fig.1B), an array of electrodes (Figs.4-5, also see "electrode array" in lines 46 & 49 of col.2) implanted proximate to the retina (Fig.1B), and signal processing circuitry coupled to the secondary coil and responsive to the output signal for applying an image signal to the array of electrodes for electrically stimulating the retina to present an apparent image to the user (Fig.6), further including a hermetically sealed housing containing the signal processing circuitry (see "encased in a biologically inert housing" in lines 15-16 of abstract), and wherein the housing is supported in the vitreous chamber in thermal contact with the vitreous body (Fig.1B), wherein the housing defines first and second perpendicularly oriented dimensions and wherein the housing is oriented in the vitreous chamber with the lesser of the dimensions extending substantially perpendicular to the axis of the secondary coil (Fig.2).

Regarding claim 20, Michelson discloses a method for implanting a visual prosthesis in the eye of a user (Figs.1-6), including fixing a secondary coil (37 of Figs.2-3, also see "coil" in line 8 of col.5) in the vitreous chamber of the user's eye in thermal contact with the vitreous body in the chamber (Fig.1B), mounting a protective housing (see "encased in a biologically inert housing" in lines 15-16 of abstract) containing signal processing circuitry (Fig.6) in close proximity to the secondary coil (Fig.2), connecting an electrode array (Figs.4-5, also see "electrode array" in lines 46 & 49 of col.2) to the user's retina (Fig.1B), electrically connecting the signal processing circuitry to the secondary coil and the electrode array (Fig.6).

Regarding claim 21, Michelson discloses a method of deploying a visual prosthesis for a user to at least partially restore vision (Figs.1-6), comprising generating a real image signal representative of a real image (see "image sensors...signal" in lines 27-29 of col.5), mounting a protective housing (see "encased in a biologically inert housing" in lines 15-16 of abstract) containing signal processing circuitry (Fig.6) in the vitreous body of a user's eye in good thermal contact therewith (Fig.1B), coupling the real image signal to the signal processing circuitry to produce an apparent image signal (Fig.6), connecting an electrode array (Figs.4-5, also see "electrode array" in lines 46 & 49 of col.2) to the user's retina (Fig.1B), and applying the apparent image signal to the electrode array (Fig.6).

Allowable Subject Matter

4. Claims 3-5, 9-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. Claims 11-19 are allowed.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chow et al ('087), Chow et al ('423), Chow et al ('317), Scribner, Greenberg et al ('758), Greenberg et al ('747), Nisch et al ('250) and Nisch et al ('270) are cited to show methods and devices for a user's eye.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadi H. Dahbour whose telephone number is 703-306-5479. The examiner can normally be reached on M-F, 9am-5pm est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

Fadi H. Dahbour
Examiner
Art Unit 3742

March 7, 2003


Teresa Walberg
Supervisory Patent Examiner
Group 3700